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KLARQUIST SPARKMAN CAMPBELL
LEIGH & WHINSTON
ONE WORLD TRADE CENTER SUITE 1600
121 S W SALMON STREET
PORTLAND, OR 97204

EXAMINER

LOCKER, HOWARD J

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 19

Application Number: 09/255,107
Filing Date: February 22, 1999
Appellant(s): HARKNESS ET AL.

Kenneth S. Klarquist, Esq.
For Appellants

MAILED
JUL 01 2003
GROUP 2900

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 3, 2002. A notice was mailed from the Office on November 15, 2002 requested copies of the applied foreign publications, and appellants provided same in a communication mailed January 02, 2003 which was never received by the Office. Appellants submitted same by facsimile on April 21, 2003, said copies have been entered into the application file.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments after Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of claims*

There is only a single claim.

(8) *Claims appealed*

There is only a single claim, and that claim is appealed.

(9) *Prior Art of Record*

NZ PBR ROS 511 (application and denomination published on January 14, 1995), which matured into Grant/Reg. Number 1131 (published on October 14, 1996).

GB Grant/Reg. Number 5467 (published on December 30, 1993).

Cooper, "Biotechnology and the Law", Section 8.05, pages 8-15 to 8-16 (August 2000), Clark, Boardman, Callaghan.

(10) *Grounds of Rejection*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 (the claim) is rejected under 35 U.S.C. 102(b) as the instant plant 'HARyup' was described in the following printed publications more than one year prior to the date of application for Plant Patent (March 12, 1999) in the United States:

- (1) NZ PBR ROS 511 (application and denomination published January 14, 1995), which matured into Grant/Reg. Number 1131 (published October 14, 1996); and
- (2) GB Grant/Reg. Number 5467 (published December 30, 1993).

At page 2 of the October 01, 2001 response, appellants have admitted that "*the rose variety of the subject application was placed on public sale in the United Kingdom in November, 1992*". In the copy of the above referenced GB document (furnished by appellants and received into the record on April 21, 2003 by facsimile transmission) it is set forth that the first offer for sale occurred in October 1992 in the UK.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the printed publication, combined with knowledge in the prior art, would have enabled one of ordinary skill in the art to reproduce the claimed plant, and said printed publication was published more than one year prior to the date of application in the United States (*In re LeGrice*, 301, f.2d 929, 133 USPQ 365 (CCPA 1962)). If one skilled in the art could have reproduced the plant from a publicly available source, then the publication describing the plant would have an enabling disclosure. See *Ex Parte Thomson*, 24 USPQ-2d, 1618, 1620, (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokora was on public use or sale in the United States but, rather, whether Siokora seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokora cultivar disclosed in the cited publications."). See also MPEP 2121.03.

It has been determined, and explicitly conceded on the record by appellants, that the above publicly available publications disclose the claimed plant variety and that said claimed variety was placed on public sale (at least in the United Kingdom in October and November of 1992) more than one year prior to the filing date of the subject application for United States Plant Patent.

As such, the published applications, accepted denomination, and published grant relied upon, combined with the knowledge in the prior art, would have enabled one of ordinary skill in the art to reproduce the claimed plant. Information regarding the claimed variety, in the form of the publications noted above, was readily available to interested persons of ordinary skill in the art.

A publication relied upon as prior art under 35 U.S.C. 102(b) must be enabling. The text of the relied upon publications standing alone would not have enabled one skilled in the art to practice the claimed invention. When a claim is drawn to a plant, the reference, combined with knowledge in the prior art, must enable one of ordinary skill in the art to reproduce the plant. The admission of prior sale and offer for sale more than one year prior to the filing date of the instant application enables the referenced documents because the disclosed cultivar could have been propagated from publicly available materials, and one skilled in the art would have the knowledge of how to do so, given the notoriety of various methods of asexual propagation. See, e.g., *Thomson*, supra. See also Cooper, "Biotechnology and the Law", Section 8.05, pages 8-15 to 8-16 (August 2000), Clark, Boardman, Callaghan ("In essence then, a plant patent

applicant cannot lose his rights through public description of the new variety so long as he does not make the stock available for propagation by the public.”).

(11) Response to Arguments

Appellants argue that the examiner's position was rejected 40 years ago in *In re LeGrice*. The allegation that the basis of rejection “flies in the face of *In re LeGrice*” or otherwise denigrates the competence of the *LeGrice* Court is inaccurate. Contrary to appellants assertion, the fact in the instant case are not identical to those presented in *LeGrice*. The *LeGrice* decision states “The particular question of law to be here decided is presented on stipulated facts, which, insofar as they relate to the issue, are here quoted from the record...” 133 USPQ at 367. The list of facts that follows does not include the stipulation that the plants sought to be patented were on sale anywhere.

Appellants argue that the CCPA did not hold that the Board was wrong in finding the “fact of sale” irrelevant and tha the court did not hold that the “fact of sale” made the publications enabling. This argument is not persuasive because there was no “fact of sale”. Applicant LeGrice never stated that the claimed plants were on sale, nor did he provide copies of the catalogue publications (Brief, Appendix B, pages 10-11). It appears that the Board's conclusion that the plant was on sale and in public use in England had no basis in fact. Naturally, the applicant did not comment on this conclusion because the Board went on to state that it was irrelevant, i.e. not the basis for the rejection (Brief, Appendix B, page 22, last paragraph).

Appellants argue that *LeGrice* requires that a printed publication enable one skilled in the art to independently produce the claimed plant from starting material other than the claimed plant itself. This argument is not persuasive because the *LeGrice* decision does not impose such a requirement. The *LeGrice* decision states, "*Basically, section 102(b) requires that an inventor, who has placed his invention in the public domain, file his application within one year thereafter...*" (133 USPQ 365, 371). Clearly, the court did not believe that the claimed plant was in the public domain. Absent public availability of the plant, the only means to produce it would be to independently re-create it by repeating the original hybridization and selection processes. While one could theoretically obtain the same plant by this methodology, the court correctly ruled that this would not be practical. The *LeGrice* decision essentially states that mere words could not put one skilled in the art in possession of the claimed plants. In the instant application, however, there is more than mere words – there is the ready public availability of the claimed plant itself, which would enable one skilled in the art to duplicate the plant many times over without further exercise of inventive skill.

It is also of interest to note that the Court cited Robinson on Patents, which listed the requirements for a document to be considered a "printed publication". Among the requirements is that the document must be "so precise and so particular that *any person skilled in the art* to which the invention belongs can construct and operate it without experiments and without further exercise of inventive skill." 133 USPQ at 369 (emphasis added). If a rose plant is commercially available, the nurseryman who sells the plant, or the amateur rose enthusiast who purchases it, would readily be able to reproduce the

plant by cuttings, budding, grafting, etc., without undue experimentation or exercise of inventive skill.

The Court also noted that "...only an 'enabling' publication is effective as a bar to a subsequent patent. We do not agree with the view expressed by the examiner that this necessarily requires that plant publications be 'totally ignored.' " 133 USPQ at 374. Appellant's position appears to be that all printed publications are, by definition, non-enabling in the plant art and therefore no rejection can ever be made over a printed publication. This is contrary to what the *LeGrice* Court stated in their decision.

The Court concluded, "The mere description of the plant is not necessarily an 'enabling' disclosure." 133 USPQ at 378. In the instant application, there is more than a "mere description" of the plant – there is also evidence of public availability of the same more than one year before the instant application was filed. The claimed plant is within the "knowledge of those skilled in the art" by virtue of its public availability. One skilled in the art would thus have known "how to make" the claimed plant upon reading the cited publications, by purchasing a clone of the plant and asexually propagating it by cuttings or any other known method in the art. Thus, the publications provide an enabling disclosure when combined with the knowledge of the skilled artisan.

Relative to appellants' continuing insistence that the *LeGrice* Court knew the plant was on sale because the Board said so, it must again be mentioned that the question of "publication plus sale" was not before the Court; only the question of "publication alone" was before them. Further, there does not appear to be any evidence of sale, just a conclusion by the Board that does not appear to be based upon any

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substantive evidence. As noted above, copies of the catalogue publications were not provided by the applicant – how could the examiner of the Board have known precisely what they disclosed? Not only was the Board's statement conclusory without any evidence, but this conclusion was followed by a further conclusion that public use or sale would have been irrelevant in any regard, as the references would be proper prior art in and of themselves. Therefore the *LeGrice* Court was not reviewing (or implicitly agreeing with) the statements by the Board regarding public use or sale, but rather was reviewing the Board's decision, which, explicitly, did not involve public use or sale enablement issues.

The examiner agrees that the publication "by itself" would not enable a person skilled in the art to reproduce the claimed plant. However, the availability of the plant whether through sale or other form of public availability would enable the disclosure of the printed publication. The allegation that the rejection has been based upon a combination of two types of evidence that are not statutory bars remains unpersuasive. The rejection is not based upon a combination of a printed publication and foreign use or sale, but rather over the printed publication alone. Foreign commercial availability is simply evidence supporting the enabling nature of the publication.

The contention that foreign commercial availability or public use is not a bar to patentability under 35 U.S.C. 102(b) is noted but is not relevant. The clear wording of 35 U.S.C. 102(b) is "A person shall be entitled to a patent unless - ... (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for

patent in the United States...". There is no geographic limitation of the bar under 35 U.S.C. 102(b) to printed publications in this country. There is no requirement that a printed publication that describes the invention be printed or enabled in this country. The second clause of 35 U.S.C. 102(b) barring public sale or use in this country is not relevant because as noted above, the current rejection under 35 U.S.C. 102(b) is based on foreign published documents ("printed publications"), as enabled by the admitted availability of the plants outside the United States more than one year prior to the date of domestic filing.

That the claimed plant was not available in the United States more than one year prior to the date of domestic filing is not relevant to patentability, as there is no geographic component of enablement. For a patent specification to be enabling, there is no requirement that the starting material required to produce the claimed invention must be located in the United States. See, for example, *Ex Parte Rinehart* 10 USPQ2d 1719, 1720 (Bd. Pat. App. & Inter. 1989), where a specification was found to be enabling even though the required biological material was not deposited, but was obtainable from specified locations in the ocean (specifically, only off the coast of Central and South America, as described in U.S. Patent 4,548,814, col. 1, lines 43-60).

Appellants assert that the plant at issue in *LeGrice* was available only in a foreign country, and that the fact situation there is the same as in the instant application. This assertion is incorrect. In *LeGrice*, applicant never admitted that the rose cultivar was on sale anywhere. Instead applicant acknowledged, "Prior public use or sale are the avenues by which a plant enters the public domain" 133 USPQ at 371.

Appellants continue to maintain that the rejection under 35 U.S.C. 102(b) is improperly applied because the availability of the rose in a foreign country did not "enable" the publication. As has been stated previously on the record, when the claimed subject matter is disclosed identically by a reference, an additional reference may be relied upon to show that the primary reference (the PBR published document) has an "enabled" disclosure.

There is no indication in the *LeGrice* decision that the Court considered whether the claimed plant had been on sale. The *LeGrice* decision repeatedly returns to the question of where the invention "was in the possession of the public" based solely on the words set forth in the printed publications. As stated by the Board in *Thomson*, "the court's holding was based on the specific 'printed publications' before it, and no indication was given that the 'prior catalogue publication' before it evidenced commercial availability in a readily enabling form." 24 USPQ2d at 1621.

Appellants argue that *In re Samour* 571 F.2d 559, 197 USPQ 1 (CCPA 1978) and *In re Donohue*, 766 F.2d 531, 225 USPQ 619 (Fed. Cir. 1985) do not support use of the publication and foreign availability upon which the rejection is based. In *Samour* as in *Donohue*, the secondary evidence, such as other patents or publications to show the state of the art can be cited to show that the primary reference contains an "enabling disclosure." The Court states in *In re Donohue* (226 USPQ at 621):

It is well settled that prior art under 35 U.S.C. § 102(b) must sufficiently describe the claimed invention to have placed the public in possession of it. 7 *In re Sasse*, 629 F.2d 675, 681, 207 USPQ 107, 111 (CCPA 1980); *In re Samour*, 571 F.2d at 562, 197 USPQ at 4; see also *Reading & Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 64, 651-52, 223 USPQ 1168, 1173 (Fed. Cir. 1984). Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his own knowledge to

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make the claimed invention. See *In re LeGrice*, 301 F.2d at 939, 133 USPQ at 373-74. Accordingly, even if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it was not enabling. In *re Borst*, 345 F.2d 851, 855, 45 USPQ 554, 557 (CCPA 1965), cert. denied, 382 U.S. 973, 148 USPQ 771 (1966.) It is not, however, necessary that an invention disclosed in a publication shall have actually been made in order to satisfy the enablement requirement.

Therefore, a foreign disclosure describing the claimed subject matter, published over a year prior to the filing of the domestic application, is an enabling bar under 35 U.S.C. 102(b) where the plant stock necessary for the publication could have been obtained over a year prior to the domestic filing of an application.

Appellants again argue that the examiner should not rely upon *Thomson* as this decision is contrary to *LeGrice* and as such was wrongly decided. This argument is not persuasive. The question in *Thomson*, as in *LeGrice*, was "what is required to 'enable' a printed publication describing a plant?" Except for the type of patent sought, the instant application presents the same fact pattern as in *Thomson*. The printed publications cited in *Thomson* were not enabled by applicant's deposit of seeds, but by the commercial availability of the seeds outside the United States. As stated in *Thomson*, "we are convinced that the skilled cotton grower would have had the wherewithal, upon reading the publicly disseminated reference articles, to purchase the commercially available Siokora seeds, and employ conventional techniques to plant and nurture the seeds to maturity in order to obtain the claimed invention, i.e., Siokora plants, seeds, and pollen. It is reasonable to conclude that, at the time the cited articles were published, skilled artisans throughout the world would have found Siokora seeds readily available on the open market." 24 USPQ2d at 1620.

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Public notice of a Plant Breeder's Right application informs the public of the existence of the plant. Notice and/or publication gives the name of the breeder/applicant, who can then be contacted to obtain the plant if it is on sale. Sale or other public use of said plant then puts it within the knowledge of one skilled in the art. If a printed publication, when taken in conjunction with the knowledge of those skilled in the art, provides an enabling disclosure, then the printed publication can be a statutory bar. The following is a passage from *LeGrice*, 133 USPQ at 379:

The mere description of the plant is not necessarily an "enabling" disclosure. Such descriptions, just as in the case of other types of inventions, in order to bar the issuance of a patent, must be capable, when taken in conjunction with the knowledge of those skilled in the art to which they pertain, of placing the invention in the possession of those so skilled.

The information in the relied-upon printed publications taken in conjunction with the knowledge of those skilled in the art (including the sale or public availability of the plant and methods of asexual propagation) would enable a person skilled in the art to reproduce the plant, thus the publication is a statutory bar under 35 U.S.C. 102(b).

The contention that asexually propagating the plant is not "making" the plant is not persuasive and is not supported by any legal authority. Asexual reproduction clearly makes what is claimed. Therefore, one of ordinary skill in the art can make and use (via asexual reproduction) the claimed invention without undue experimentation. There is no statutory requirement or case law specifying that for a prior art reference to be enabling, it must enable one skilled in the art to "make the plant of the invention from source material other than the plant itself."

Moreover, while asexual reproduction of a patented plant infringes a United States Plant Patent, independent creation of an identical plant, as envisioned by Appellants, would not. See *Imazio Nursery Inc. v. Dania Greenhouses*, 26 USPQ2d 1673, wherein the conclusion of the CAFC was expressed as follows:

"In view of the statutory language, the legislative history, the case law, the views of the commentators, and a review of the relevant provisions of the PVPA, we conclude that the scope of a plant patent is the asexual progeny of the patented plant variety. Variety as used in section 161 encompasses a single plant, the plant shown and described in the specification."

So, if this application were to mature into a patent, an identical plant produced by "independent creation" as contemplated by Appellants would not infringe the patent. In *Imazio Nursery Inc. v. Dania Greenhouses* (CA FC) 36 USPQ2d 1673, the court stated (page 1681):

The statute requires asexual reproduction of the patented plant for there to be infringement, it is necessarily a defense to plant patent infringement that the alleged infringing plant is not an asexual reproduction of the patented plant. Part of this proof could be, thus, that the defendant independently developed the allegedly infringing plant. However, the sine qua non is asexual reproduction. That is what the patentee must prove and what the defendant will seek to disprove.

Moreover, it is noted that the process of asexual reproduction and the plant so produced are the invention that is protected by a United States Plant Patent. As stated in 35 U.S.C. 163:

In the case of a plant patent, the grant shall include the right to exclude others from asexually reproducing the plant, and from using, offering for sale, or selling the plant so reproduced, or any of its parts, throughout the United States, or from importing the plant so reproduced, or any parts thereof, into the United States.

Since the asexually reproduced plant is what is patented, the process for its production is, by definition, "making" the invention.

The argument that the *Thomson* decision is not in accordance to the law for the instant application as the *Thomson* application was drawn to a utility patent is not persuasive as *In re LeGrice*, 35 U.S.C. 161, and 36 CFR 1.161 clearly state that the same laws and rules relating to applications for utility patents also are applicable to plant patents except for the one exception set forth in 35 U.S.C. 162.

The argument that the rejection is improper because the reference relied upon does not teach every aspect of the claim, and that references may not be combined in a rejection under 35 U.S.C. 102 is not persuasive for two reasons. First, appellants have admitted that the plant disclosed in the references is in fact the same plant which is claimed. Therefore the prior art plant inherently possesses all of the characteristics of the claimed plant as it is the same plant. Appellants have not pointed out what aspect of the claimed plant is missing from the plant as disclosed by the prior art. Second, there is no other reference. Appellants have not explained how the admission that the plant was publicly available constitutes a "reference". Even if one were to assume, *arguendo*, that this admission is a reference, it is not used to compensate for any "deficiency" in the primary reference. Appellants' admission is being used only to document that the claimed invention was in possession of the public, which is permissible in a rejection under section 102. See MPEP 2101.01

Continuing arguments brought forth relative to reversal or departure from prior practice are not sufficient to overcome the rejection of record. The Office is applying 35 U.S.C. 102(b) to a given factual pattern. The factual pattern is analogous to the opinion

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in *Ex Parte Thomson*, which demonstrates the strength of 35 U.S.C. 102(b) under such circumstances. The USPTO cannot ignore 35 U.S.C. 102(b) just because of the recognition of a recurring fact pattern that runs counter to that paragraph where it may not have been recognized before. "The fact that the PTO may have failed to adhere to a statutory mandate over an extended period of time does not justify its continuing to do so." *In re Donaldson Co.*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1849 (Fed. Cir. 1994).

Arguments relative to permanent v. indeterminate length of time that the invention is placed in possession of the public are not persuasive because there is no support in 35 U.S.C. 102(b)/"enablement of references" jurisprudence for such a distinction. Once a publication is enabled and becomes part of the prior art, then it cannot be removed from the realm of prior art.

The balance of the arguments brought forth by appellant, such as the mechanical device discussion at page 23 of Appellants' brief have been considered, but are not persuasive. As acknowledged by appellants, no reported case has been found discussing the hypothetical fact situation presented by appellant. Furthermore, mechanically identical devices cannot be identically reproduced in the way that plants can. Simply buying/accessing a new machine does not necessarily enable one skilled in the art to make and use it, as such a machine cannot necessarily be identically replicated by known means without undue experimentation.

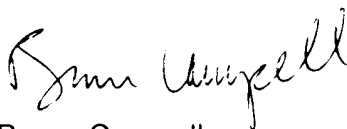
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For the above reasons, it is believed that the rejection should be sustained.

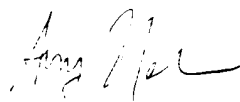
Respectfully submitted,



Howard J. Locker/hjl
June 24, 2003



Bruce Campell
SPE, Art Unit 1661
Conferee



Amy Nelson
SPE, Art Unit 1638
Conferee

BRUCE R. CAMPPELL, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

AMY J. NELSON, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

KLARQUIST SPARKMAN CAMPBELL LEIGH
& WHINSTON
ONE WORLD TRADE CENTER SUITE 1600
121 S W SALMON STREET
PORTLAND, OR 97204